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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Sten Andersson

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140 7590 02/15/2008  
LADAS & PARRY LLP  
26 WEST 61ST STREET  
NEW YORK, NY 10023

EXAMINER

CHANG, EDWARD

ART UNIT

PAPER NUMBER

4143

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02/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/506,939	<b>Applicant(s)</b> ANDERSSON ET AL.	
	<b>Examiner</b> EDWARD CHANG	<b>Art Unit</b> 4143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on March 17, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 1,3,4,8,9,17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on September 8, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>April 4, 2005</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the national stage application completed on 17<sup>th</sup> of March 2005.
2. Claims 1-19 are currently pending and have been examined.
3. For the purpose of this examination, the examiner will give the priority date back to 13<sup>th</sup> of March 2002.

### Information Disclosure Statement

4. The Information Disclosure Statement filed on April 4, 2005 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### Claim Objections

5. Claim 1 objected to because of the following informalities: Spelling errors "...*asymmetric encryption using **en** asymmetric key...*" and "...*second user by **initialising** a verification...*" Appropriate corrections are required.
6. Claim 3 objected to because of the following informalities: Spelling error "...**Servicesystem**..." Appropriate correction is required.
7. Claim 4 objected to because of the following informalities: Spelling error "...**lr**..." Appropriate correction is required.
8. Claim 8 objected to because of the following informalities: Spelling error "...*cheque is **fransmitted** via...*" Appropriate correction is required.

Art Unit: 4143

9. Claim 9 objected to because of the following informalities: Spelling error "...subsequently is **transmited** to..." Appropriate correction is required.

10. Claim 17 objected to because of the following informalities: Spelling errors "...a second **primate** key..." and "...second user by **initialising** a verification..." Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

#### **As per Claims 3, 12, and 18:**

- The claims 3, 12, and 18 recite the limitation ***the Short Message Service system over the GSM system***. There are insufficient antecedent basis for this limitation in the claim. Appropriate corrections are required.

#### **As per Claims 5 and 14:**

- The claims 5 and 14 recite ***the account***. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

#### **As per Claim 7:**

- The claim 7 recites ***the conformation***. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

**13.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**14.** The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**15.** Claims 1-12 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Doggett et al. (hereinafter "Doggett"); (Patent# 5,677,955) in view of Adam et al. et al. (hereinafter "Adam"); (US 2002/0181710 A1).

**As per Claims 1, 10, and 17:**

Doggett as shown also discloses the following limitations:

- *processing en electronic payment cheque that relates to a transfer of an amount of money from an account of a first user in a first banking institute (500) to an account of a second user in a second banking institute (550), (See at least Column 3, Line 2+, "electronic instrument...")*
- *processing includes generating digital signatures by means of asymmetric encryption using en asymmetric key pair comprising a private key and a public key, characterized in that, the method comprises the following steps: (See at least Column 3, Line 43~65)*

Art Unit: 4143

- *in a first SIM card (101a) of the first user, creating an electronic payment cheque and signing the electronic payment cheque with a first signature generated by means of a first private key of a first asymmetric key pair, (See at least Column 3, Line 59+, "portable token having a memory...contains a private encryption...")*
- *which first private key is generated on the first SIM card (101a) and resides on the first SIM card (109a) hosted by a first mobile equipment (101b), (See at least Column 2, Line 60+, SIM card = "IC chip cards", mobile equipment = "computer or a terminal")*
- *via the first mobile equipment (10b) hosting the SIM card (101a) of the first user, transmitting the signed electronic payment cheque to a second SIM card (102a) hosted in a second mobile equipment (102b) of the second user, (See at least Column 8~9, Line 60+, transmission between two computing device with two signature cards)*
- *in the second SIM card (102a), signing the electronic payment cheque, which has been signed with the first signature, with an additional second signature generated on the second SIM card (102a) by means of a second private key of a second asymmetric key pair, which second private key is generated on the second SIM card 99977(102a) and resides on the second SIM card (102a) hosted by the second mobile equipment (102b), (See at least Column 4, Line 6+, "the portable token may be a PCMCIA compatible card, smart card...."); (Also see at least Column 4, Line 20+, "the appended signature may be a signature of a payer....or an endorsement signature of a payee" )*
- *transmitting the electronic payment cheque signed with the first and the second digital signatures from the second mobile equipment (102b) to a central hub (300), which central hub (300) is in communication with the first and the second banking institutes (500, 550), in the central hub (300), (See at least Column 2, Line 35+, "bank's centralized computer...")*

Art Unit: 4143

- *Initiating a deposit of the amount of money in the electronic payment cheque into the account of the second user by initializing a verification of the second signature at the banking institution (550) of the second user and a verification of the first signature at the banking institution of the first user (500). (See at least Column 1, Line 48, "If the check looks authentic, the payee bank..."); (Also see at least Column 1, Line 56, "the payer's bank which then verifies the authenticity of the check and the signature of the payer...")*

Doggett uses a set of computers with memory cards but specifically does not disclose the using mobile phones with SIM cards to accomplish the transaction. But Adam however as shown does:

- *...first SIM card (109a) hosted by a first mobile equipment... (See at least Page 1, Paragraph 0011, "...cellular phone operating with a SIM card...")*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's transaction system using mobile phones to accomplish transactions using electronic cheque between two mobile phones. The mobility of the phones will help the users to effectively and quickly complete a transaction when and wherever it is necessary. *"The availability of cellular phones and their widespread distribution together with the realization that cellular phones are in fact sophisticated communication devices led to the introduction of m-commerce (mobile commerce) - cellular phones as means for conducting payments."* (See at least Page 1, Paragraph 0004)

**As per Claims 2 and 11:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Doggett as shown, also discloses the following limitations:

- *the transmittal of the signed electronic payment cheque from the first mobile equipment (101b) hosting the SIM card (101a) of the first user to the second SIM*

*card (102a) hosted in a second mobile equipment (102b) of the second user, is performed via a digital mobile telephone system. (See at least Fig. 4, Column 8~9, Line 60+, "...the electronic check, to be passed electronically to other parties to the transaction via one of the electronic networks...")*

Doggett uses a set of computers with memory cards to transmit the signed electronic payment but specifically does not disclose the using mobile phones with SIM cards to accomplish the transaction. But Adam however as shown does:

- *performed via a digital mobile telephone system (See at least Column 1, Paragraph 0001, "...a system and method of financial transactions using mobile phones...")*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's transaction system using mobile phones to accomplish transactions using electronic cheque between two mobile phones. The mobility of the phones will help the users to effectively and quickly complete a transaction when and wherever it is necessary. *"The availability of cellular phones and their widespread distribution together with the realization that cellular phones are in fact sophisticated communication devices led to the introduction of m-commerce (mobile commerce) - cellular phones as means for conducting payments."* (See at least Page 1, Paragraph 0004)

**As per Claims 3, 12, and 18:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Doggett as shown, also discloses the following limitations:

- *the signed payment cheque is transmitted as a Short Message by means of the Short Message Service system over the GSM system. (See at least Column 3, Line 19, "Digital representations of a verifiable signature of the payer may also be appended to the electronic instrument. The electronic instrument may be delivered electronically*



*to the institution at least in part via a publicly accessible data communication medium.”)*

Doggett specifically does not disclose the using of SMS in a GSM system to accomplish the transaction. But Adam however as shown does:

- *as a Short Message by means of the Short Message Service system over the GSM system. (See at least Fig. 4, Using of GSM network; also see Page 2, Paragraph 0024, “...conducted using SMS protocol”)*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett’s electronic instrument as taught by Adam’s transaction system using mobile phones to accomplish transactions using electronic cheque on a SMS between two mobile phones. The mobility of the phones will help the users to effectively and quickly complete a transaction when and wherever it is necessary. *“The availability of cellular phones and their widespread distribution together with the realization that cellular phones are in fact sophisticated communication devices led to the introduction of m-commerce (mobile commerce) - cellular phones as means for conducting payments.”* (See at least Page 1, Paragraph 0004)

**As per Claims 4 and 13:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Doggett as shown, also discloses the following limitations:

- *the signed payment cheque is transmitted as a Short Message by means of Ir, Bluetooth or Wi-Fi standards. (See at least Column 7, Line 23, “electronic networks such as the dial-up, Internet, wireless...”)*

**As per Claims 5 and 14:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Doggett as shown, also discloses the following limitations:

Art Unit: 4143

- *payment cheque comprises indicating a telephone number associated to the second SIM card (102a), an amount to be transferred and an index to the account, wherefrom the amount should be withdrawn. (See at least Column 10, Line 5~21)*

**As per Claim 6:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Adam as shown, also discloses the following limitations:

- *via the first mobile equipment (101b), prompting the first user to confirm creation of an electronic payment cheque, which prompting is initiated at the first SIM card (101a) hosted by the first mobile equipment (101b). (See at least Page 6, Paragraph 0124~0125, "...asked to authorize the transaction by sending an authorization message...Yet another identification form may be the generation, within the mobile phone...as presented on the phone display...")*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's transaction system using mobile phones to prompt the user to confirm creation of an electronic payment cheque. This would greatly lower the risk of fraud or mistake. *"Due to the nature of the transaction method of the present invention described herein this risk is eliminated (or greatly reduced)..."* (See at least Page 6, Paragraph 0124)

**As per Claim 7:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Adam as shown, also discloses the following limitations:

- *the conformation comprises entering of a PIN-RSA number. (See at least Page 6, Paragraph 0131, "...requesting a PIN for authentication.")*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's

Art Unit: 4143

transaction system using mobile phones to prompt the user for a PIN to confirm creation of an electronic payment cheque. This would greatly lower the risk of fraud or mistake. *"Due to the nature of the transaction method of the present invention described herein this risk is eliminated (or greatly reduced)..."* (See at least Page 6, Paragraph 0124)

**16.** Claims 8, 9, 15, 16, and 19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Doggett/Adam and further in view of Ray et al. (hereinafter "Ray"); (US 6,067,529).

**As per Claims 8, 9, 15, 16, and 19:**

The combination of Doggett /Adam discloses the limitations as shown in the rejections above.

Furthermore, Adam discloses the following limitations:

- *the encrypted electronic payment cheque is transmitted via a message proxy in the central hub (300). (See at least Fig. 4, Column 8~9, Line 60+, "...the electronic check, to be passed electronically to other parties to the transaction via one of the electronic networks...")*
- *the encrypted electronic payment cheque at the message proxy is converted to an SMS Point to-point data download message, which subsequently is transmitted to the second SIM card hosted by the second mobile equipment. (See at least Fig. 4, Column 8~9, Line 60+, "...the electronic check, to be passed electronically to other parties to the transaction via one of the electronic networks...")*

In addition, Doggett specifically does not disclose the using of message proxy in the central hub to accomplish the transaction. But Adam however as shown does:

- *a message proxy in the central hub (300). (See at least Fig. 4, CSC = central hub; also see Page 2, Paragraph 0024, "...conducted using SMS protocol")*
- *message proxy is converted to an SMS Point to-point data download message, (See at least Fig. 4, CSC = central hub; also see Page 2, Paragraph 0024, "...conducted using SMS protocol")*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Doggett's electronic instrument as taught by Adam's transaction system using mobile phones to accomplish transactions using electronic cheque on a message proxy in the central hub between two mobile phones. The mobility of the phones will help the users to effectively and quickly complete a transaction when and wherever it is necessary. *"The availability of cellular phones and their widespread distribution together with the realization that cellular phones are in fact sophisticated communication devices led to the introduction of m-commerce (mobile commerce) - cellular phones as means for conducting payments."* (See at least Page 1, Paragraph 0004, also see Fig. 4)

The combination of Doggett/Adam does not specifically state the use of *"message proxy"*. However, Ray in at least column 5, Line 8+ discloses *message proxy* in the server to properly run the *"SMS protocol."* It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Doggett/Adam with Ray because message proxy is necessary to quickly receive and convert the raw data to a text format to be efficiently used by the *"SMS protocol"*.

Art Unit: 4143

***Conclusion***

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Edward Chang** whose telephone number is **571.570.3092**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A. Reagan** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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February 5, 2008

/Edward Chang/ Examiner, Art Unit 4143

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143